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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,533	10/11/2001	Corey J. Norris	10011776-1	1510

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
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EXAMINER

CHILCOT, RICHARD E

ART UNIT PAPER NUMBER

3627

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,533

Applicant(s)

NORRIS, COREY J.

Examiner

Richard E. Chilcot, Jr.

Art Unit

3627

My

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al. alone.

With regard to claim 1, Otsuka discloses a method for transferring an electronic document from a computer (1, Fig. 5) to print media in exchange for payment that includes discovering payment account information (30, 31, Fig. 5, col. 7, line 1+), accepting an electronic document (S2, Fig. 7A), transferring the electronic document to print media (col. 14, line 21+), determining a price for the service (col. 16, line 40+, inherent in the invention), and executing a payment transaction at the determined price (col. 16, line 40+, S\$, Fig. 7A). The computer is not shown to mobile; however, mobile computers (laptops, PDAs, etc.) are well known and would have been obvious for one having ordinary skill in the art at the time of the invention to substitute or employ a mobile computer in the method of Otsuka (col. 1, line 58+). Furthermore, it would have been obvious for the skilled artisan that various components of a device (for example, output apparatus, input means, computing apparatus, etc.) could be contained in an integral unit or divided into separate units assigned functions as dictated by design.

With regard to claims 2 and 3, discovering the payment account information includes reading information from an encoded strip (col. 7, line 5+, common practice with credit cards) or receiving a transmission with payment information (Fig. 5).

With respect to claim 4, accepting the electronic document includes receiving a transmission including the document (S%, Fig. 7A, col. 8, line 1+).

Concerning claim 5, it would have been obvious for the skilled artisan to charge a fee based on the number of pages printed, since this is common practice in the printing business.

With respect to claim 6, payment account information is verified (col. 6, line 61).

Concerning claim 7, after the payment account information is received, the document is printed (Fig 7A).

Claims 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al. alone.

With regard to claim 8, Otsuka discloses an output apparatus for transferring an electronic document from a computer (1, Fig. 5) to print media in exchange for payment that includes discovering payment account information (30, 31, Fig. 5, col. 7, line 1+), accepting an electronic document (S2, Fig. 7A), transferring the electronic document to print media (col. 14, line 21+), determining a price for the service (col. 16, line 40+, inherent in the invention), and executing a payment transaction at the determined price (col. 16, line 40+, S\$, Fig. 7A). The computer is not shown to mobile; however, mobile computers (laptops, PDAs, etc.) are well known and would have been obvious for one having ordinary skill in the art at the time of the invention to substitute or employ a mobile computer in the method of Otsuka (col. 1, line 58+). Furthermore, it would have been obvious for the skilled artisan that various components of a device (for

Art Unit: 3627

example, output apparatus, input means, computing apparatus, etc.) could be contained in an integral unit or divided into separate units assigned functions as dictated by design.

With regard to claims 9 and 10, discovering the payment account information includes reading information from an encoded strip (col. 7, line 5+, common practice with credit cards) or receiving a transmission with payment information (Fig. 5).

With respect to claim 11, accepting the electronic document includes receiving a transmission including the document (S%, Fig. 7A, col. 8, line 1+).

Concerning claim 12, it would have been obvious for the skilled artisan to charge a fee based on the number of pages printed, since this is common practice in the printing business.

With respect to claim 13, payment account information is verified (col. 6, line 61).

Concerning claim 14, after the payment account information is received, the document is printed (Fig 7A).

Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al. alone.

With regard to claim 15, Otsuka discloses a program storage system embodying a program executable by a computer to perform the steps of a method for transferring an electronic document from a computer (1, Fig. 5) to print media in exchange for payment that includes discovering payment account information (30, 31, Fig. 5, col. 7, line 1+), accepting an electronic document (S2, Fig. 7A), transferring the

Art Unit: 3627

electronic document to print media (col. 14, line 21+), determining a price for the service (col. 16, line 40+, inherent in the invention), and executing a payment transaction at the determined price (col. 16, line 40+, S\$, Fig. 7A). The computer is not shown to mobile; however, mobile computers (laptops, PDAs, etc.) are well known and would have been obvious for one having ordinary skill in the art at the time of the invention to substitute or employ a mobile computer in the method of Otsuka (col. 1, line 58+). Furthermore, it would have been obvious for the skilled artisan that various components of a device (for example, output apparatus, input means, computing apparatus, etc.) could be contained in an integral unit or divided into separate units assigned functions as dictated by design.

With regard to claims 16 and 17, discovering the payment account information includes reading information from an encoded strip (col. 7, line 5+, common practice with credit cards) or receiving a transmission with payment information (Fig. 5).

With respect to claim 18, accepting the electronic document includes receiving a transmission including the document (S%, Fig. 7A, col. 8, line 1+).

With respect to claim 19, payment account information is verified (col. 6, line 61).

Concerning claim 20, after the payment account information is received, the document is printed (Fig 7A).

Response to Arguments

With respect to applicants' argument that Otsuka et al. does not teach a mobile computer is noted; however, applicants have failed to address the combination

set forth in the Office action. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

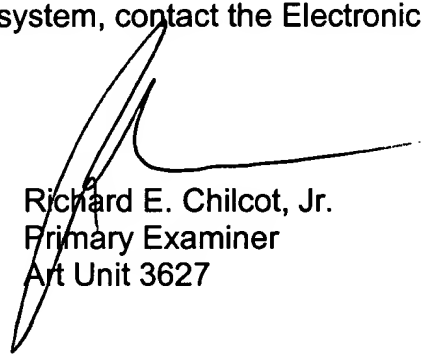
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard E. Chilcot, Jr. whose telephone number is 703-305-4716. The examiner can normally be reached on 5/4/9 1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3627

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard E. Chilcot, Jr.
Primary Examiner
Art Unit 3627